

REMARKS

Applicant submits this Amendment in response to the Office Action of July 13, 2005.

The application has been amended as follows. Because all pending claims call for a method, the Title of the application has been amended to delete the term “and kit”. Likewise, the Abstract has been amended to delete the term “and kits”.

Independent claim 1 has been amended to incorporate the feature that a chemical compound that has both cannabinoid receptor agonism and COX-2 inhibition is administered. The feature of one compound having both of these activities was previously called for in claims 5 and 6, which have been canceled. A similar amendment was made to independent claims 12 and 17. This feature had been called for in dependent claims 16 and 19, respectively, each of which has been canceled. Claims 4 and 10, and claims 18 and 23, have been amended to change wording in order to depend correctly from independent claims 1 and 17, respectively, in view of the amendments to the independent claims. Claims 7 and 20 have been amended to call for ajulemic acid. Support for the amendment to claims 7 and 20 is found in the specification on page 12, line 5.

Rejections of the claims

I. Rejection under 35 U.S.C. §112, second paragraph

The Examiner has rejected claims 4 and 18 under 35 U.S.C. §112, second paragraph, as being indefinite for insufficient antecedent basis for the term “wherein the COX-2 inhibitor is also a COX-1 inhibitor”. Claims 4 and 18 have been amended to delete this term and

replace it with the term “chemical compound” which has antecedent basis in independent claims 1 and 17, respectively. Applicant submits, accordingly, that the rejection of these claims on this ground is mooted and requests the Examiner to withdraw this basis of rejection.

II. Rejection under 35 U.S.C. §112, first paragraph

The Examiner has rejected claims 5, 6, and 16 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicant traverses the rejection of these claims on this ground.

Preliminarily, Applicant notes that claims 5, 6, and 16 have been canceled and the features of these claims have been incorporated into the independent claims from which they originally depended. Applicant submits that the specification in the bridging paragraph of pages 11 and 12 provides a written description of the invention claimed in claims 5, 6, and 16. That paragraph discloses that a chemical compound may have activity as a cannabinoid receptor agonist and as a COX-2 inhibitor. Such activity is taught in compounds disclosed in the Burstein and Mechoulam patents listed on page 6 of the specification. Additionally, the present specification specifically discloses that compounds having such dual activity include tetrahydrocannabinol and metabolites thereof and cannabinoids such as ajulemic acid.

Accordingly, Applicant submits that the rejection of these claims as being in violation of the written description requirement of 35 U.S.C. §112 is improper and requests the Examiner to reconsider and to withdraw the rejection of these claims on this ground.

III. Rejection for Non-Statutory Double Patenting

The Examiner has rejected claims 17 to 27 under the judicially created doctrine of double patenting in view of claims 17 to 24, 26, and 27 of U.S. Patent No. 6,916,852. Applicant traverses the rejection of these claims on this ground.

Claim 17 has been amended to call for co-administration by administering a chemical compound that has activity as a cannabinoid receptor agonist and activity as a COX-2 inhibitor. Applicant submits that the inclusion of this feature in claim 17 renders this claim, and claims 18 to 27 which depend therefrom, patentably distinct from the claims of the 6,916,852 patent.

Accordingly, Applicant requests the Examiner to reconsider and to withdraw the rejection of claims 17 to 27 for double patenting.

IV. Rejection for “Same Invention” Type Double Patenting under 35 U.S.C. §101

The Examiner has rejected claims 1 to 4 and 7 to 15 under 35 U.S.C. §101 as claiming the same invention as that of claims 1 to 5, 7 to 9, and 13 to 16 of U.S. Patent No. 6,916,852. Applicant traverses the rejection of these claims on this ground.

Independent claim 1, from which claims 2 to 4 and 7 to 11 depend, and independent claim 12, from which claims 13 to 15 depend, have been amended to call for administration of a chemical compound having the properties of both cannabinoid receptor agonism and COX- inhibition. Such a feature is not present in the claims of the 6,916,852 patent. Accordingly, Applicant submits that the rejection of claims 1 to 4 and 7 to 15 under 35 U.S.C.

§101 for double patenting is overcome and the Examiner is requested to withdraw the rejection of these claims on this ground.

V. Rejection under 35 U.S.C. §102(e)

The Examiner has rejected claims 17 and 20-27 under 35 U.S.C. §102(e) as being anticipated by the disclosure of Friary, U.S. Patent Application Publication US 2004/0010012.

Applicant traverses the rejection of these claims on this ground.

Claim 17 has been amended to call for administration of a chemical compound that has activity as a cannabinoid receptor agonist and activity as a COX-2 inhibitor. Such a feature is not disclosed nor suggested in Friary.

Accordingly, Applicant submits that the rejection of claim 17, and claims 20 to 27 which depend from claim 17, as being anticipated under 35 U.S.C. §102(e) is overcome and requests the Examiner to withdraw the rejection of these claims on this ground.

CONCLUSION

Applicant submits that the claims, as amended, are in condition for allowance and requests an early notice to that effect.

Respectfully submitted,

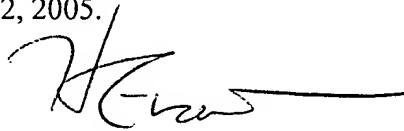


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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450 on September 2, 2005.

Dated: September 2, 2005



Howard M. Eisenberg